

Docket No.: 99 P 7399 US  
App. No.: 09/457,049

Item 3 rejects claims 1-3, [6 and/or 16], 21-23, 26, and 27 under 35 U.S.C. §103(a), (hereinafter, "Section 103(a)") as being unpatentable over Wood et al. (U.S. Patent 6,091,808) (hereinafter "Wood"). Claim 6 and not claim 16 was mentioned in the first sentence of Item 3, but claim 16 and not claim 6 was mentioned in the body of Item 3.

Item 4 rejects claims 4, 17-20, 28, and 33 under Section 103(a) as being unpatentable over Wood in view of Brennan et al. (U.S. Pat. 5,329,578), (hereinafter, "Brennan").

Item 5 rejects claim 24 under Section 103(a) as being unpatentable over Wood in view of Cheston, III et al. (U.S. Patent 6,330,308) (hereinafter, "Cheston").

Item 6 rejects claim 25 under Section 103(a) as being unpatentable over Wood in view of Herbst (U.S. Patent 4,941,170).

Item 7 rejects claim 5 under Section 103(a) as being unpatentable over Wood in view of Brennan and further in view of Kugell et al. (U.S. Patent 5,802,160) (hereinafter, "Kugell").

Item 8 rejects claims 6, 8-15, 29-32, 34, and 35 under Section 103(a) as being unpatentable over Kugell in view of Brennan.

Item 9 rejects claim 7 under Section 103(a) as being unpatentable over Kugell in view of Brennan and further in view of Will (U.S. Patent 5,905,789).

Item 10 states that Applicants previous arguments have been considered but are moot in view of the new ground(s) of rejection.

Item 11 states that the Office Action is made Final.

Items 12 and 13 give contact information for responding to the Office Action.

Claim 1 under Section 112, second paragraph [Item 1]

Claim 1 is apparently objected to as lacking clarity because "it is unclear to where a message via a first contact method is sending". Applicants thank the Examiner for careful review of the claims. Applicants respectfully submit, however, that Applicants intentionally do not intend to limit claim 1 to any

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particular destination for the message, so long as the message is sent via the first contact method as recited in claim 1. Accordingly, Applicants respectfully submit that it is not necessary or proper to consider the destination of the message to be "unclear" in claim 1. In reality, there is no particular destination recited, and therefore there is nothing about which to be unclear. Accordingly, Applicants respectfully submit that there is, in fact, no statutory basis that would require recital of a destination in claim 1. Accordingly, Applicants respectfully submit that claim 1 is clear and proper as it is written.

Claim 1-3, [6 and/or 16,] 21-23, and 27 under Section 103(a) [Item 3]

Claims 1-3, 6, 21-23, and 27 stand rejected under Section 103(a) as being unpatentable over Wood.

Not obvious to attempt somehow to modify Wood

The Office Action concedes that:

*... Wood does not teach a method to locate the called party but rather the method of making a telephone connection [via a computer interface] ... in the same manner as if the called party number had been dialed by the subscriber at the telephone."*  
[Office Action, Item 3, bottom of page 2].

Applicants respectfully agree that "Wood does not teach a method to locate the called party" and that Wood instead teaches merely a method of dialing a telephone using a computer interface connected to a telephone switch. Despite the fact that Wood's method and Applicants' method address completely different problems, the Office Action nevertheless rejects claim 1 simply by stating:

*It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method for providing telephone call control and information as described in Wood for locating the called party in order to have a complete and sufficient system.*

[Office Action, Item 3, top of page 3]

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Applicants respectfully disagree with the just-quoted assertion. Applicants are sincerely surprised that Wood is cited as a reference at all, and even more so that Wood is cited as a sole rejecting reference. Applicants are surprised because Wood does not differ much from any generic prior-art telephone. Perhaps the only interesting attribute of Wood is that Wood, as described by the Examiner in the Office Action (see quoted passage above), allows a person to use a Web interface to dial a telephone call instead of dialing from an ordinary telephone.

(As a convenience, Wood's system also allows a caller to use the system's Web user interface to email a person. See Wood, FIG. 3, which shows an "email" button in addition to a "dial" button. However, the email capability is separate from the dialing mechanism, and the email capability is not relevant to the rejections, and is not mentioned in the Office Action as being relevant to the rejections.)

Applicants respectfully point out that the entire premise underlying each use of Wood's system for dialing is that the party to be called is assumed to be at a single, already-known phone number. Then, Wood's system, like any other telephone, is used to call the single, already-known phone number. That is all. Beyond that, Wood is silent. Thus, Wood, like the simplest conventional telephone, simply does not teach or suggest Applicant's claim 1 in any manner whatsoever.

The Examiner appears to agree implicitly that there is no suggestion in any cited art to modify Wood. The Examiner's implicit agreement is seen by the Office Action's not alleging any such suggestion in any cited art. Instead, the Office Action alleges only a single motivation for somehow modifying "the method ... as described in Wood" to fulfill somehow claim 1's task of "locating the called party". The Office Action alleges that the entire motivation is as follows:

*... in order to have a complete and sufficient system.*  
[Office Action, Item 3]

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Applicants respectfully submit that the just-re-quoted alleged motivation is not logical and not adequate. For example, there is no suggestion in Wood or any other cited art that Wood's system is not "complete" or not "sufficient". Instead, Wood teaches a functioning system that already improves on the functioning existing systems mentioned in Wood's Background section. Furthermore, there is no explanation offered in the Office Action as to why the definition of "a complete and sufficient system" must, coincidentally it seems, include claim 1's exact functionality and claim 1's exact steps, in the mind of someone of ordinary skill at the time the subject of claim 1 was invented. Accordingly, Applicants respectfully submit that the Examiner has fallen into the trap of using hindsight to an impermissible degree. Applicants respectfully submit that, in fact, there was no suggestion or motivation to somehow modify Wood to somehow obtain thereby Applicants' claim 1.

Indeed, Applicants respectfully submit that, if the statement "... in order to have a complete and sufficient system" were a sufficient basis for rejecting claim 1, then that same alleged basis could be used to justify any modification or combination whatsoever of references, and thereby reject any claim by any applicant in any patent application whatsoever, in a classic example of relying excessively on hindsight.

In view of the above discussion, Applicants respectfully submit that no prima facie case of obviousness has been stated, or can be stated, for rejecting claim 1 as being unpatentable over Wood. If the Examiner wishes to maintain the rejection of claim 1 after reconsideration, Applicants respectfully request that the Examiner please provide support for any such remaining rejection by specific reference to specific portions of cited art and/or an affidavit as required by 37 C.F.R. § 1.104(d)(2).

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Wood and Modification Still Fail to Teach Or Suggest All Elements, and  
There is No Expectation of Success

The discussion in the preceding paragraphs already gives sufficient reason why claim 1 is allowable over Wood. Nevertheless, there are still further reasons.

Even on a preliminary level, it should be appreciated again that the entire premise underlying each use of Wood's system is that the party to be called is assumed to be at a single, already-known phone number. Then, Wood's system, like any other telephone, is used to make an ordinary telephone call to the single, already-known phone number. That is all. Thus, it will not be surprising to see in the discussion below that Wood's system simply does not teach or suggest all elements of claim 1, even if a person of ordinary skill somehow decided to use Wood's system somehow to "locate the called party".

Claim 1 recites, among other steps:

*upon receiving a request to locate a called party, referring to said contact list to automatically attempt to locate said called party, wherein said automatically attempt to locate said called party comprises:*

*automatically sending a message via a first contact method, said first contact method associated with a contact in said contact list, said message requesting location information regarding said called party;*

*receiving a response to said message, said response indicating a second contact method, other than said first contact method, for attempting to reach said called party; and*

*automatically processing the response to facilitate use of said second contact method to attempt to reach said called party.*

As is seen, three substeps ("sending", "receiving", "processing") recited in claim 1 are reproduced above. Each substep includes a certain amount of description. The Office Action does not explicitly address all recited parts of claim 1. Instead, the Office Action makes only the following simplified allegation, which addresses only a fraction of the language of claim 1:

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*Referring to claim 1, Wood teaches the steps of: providing a contact list (Abstract, lines 4-5); and upon receiving a request the telephone connection message, referring to said contact list (col. 1, lines 11-13), where the first contact method is via "network (web)" and the second contact method is via "telephone switch 16 (central office, PSTN, or a PBX...)", a response to the telephone connection message from the network (web) to a web browser and attempt to reach the called party (col. 2, lines 13-16).  
[Office Action, Item 3, page 2]*

As is seen, the Office Action cites only one part of Wood ("telephone connection message" and col. 2, lines 13-16) as relating to any part of the above-quoted three substeps ("sending", "receiving", "processing") of claim 1. The relevant part of Wood cited in the Office Action, along with some surrounding context, states:

*... remotely accessing a computer network facility to produce at the computer network facility a telephone connection message including information identifying calling and called telephone numbers; communicating the telephone connection message from the computer network facility to a telephone switch via a switch-computer interface; and establishing a telephone connection between the calling and called telephone numbers from the switch in response to the telephone connection message..  
[Wood, col. 2, lines 9-16, underlining added]*

It is seen that in Wood's system, the "telephone connection message" is a command to dial a single, already-known telephone number. The "telephone connection message" essentially says: "dial this number ##.. to be called (from this calling number ##..) ". The Office Action alleges that Wood's "telephone connection message" can be equated with claim 1's step of "automatically sending a message ... requesting location information regarding said called party". The Office Action also alleges that the "response" required by claim 1 to "said message, said response indicating a second contact method ..." is satisfied by Wood's "establishing a telephone connection between the calling and called telephone numbers from the switch in response to the telephone connection message" (i.e., by Wood, col. 2, lines 13-16).

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So, given that Wood's telephone connection message is simply for the purpose of calling a single, already-known telephone number, and that the alleged "response" to the message is always at most merely a telephone connection to the single, already-known telephone number to be called, Applicants do not see in what sense Wood's alleged "response" can be properly said to be "indicating a second contact method other than said first contact method" as a "response" to an alleged "message requesting location information regarding said called party". Applicants respectfully ask, what is there left for the alleged "response" to indicate, in Wood's system, given that the only contact method allegedly indicated is already known and is already the only contact method that was, or even could be, already expected to be relevant to the alleged "response"?

Further, if the "establish[ed] ... telephone connection" of Wood is, as alleged, the "response" of claim 1, then there is nothing further in Wood that teaches or suggests "automatically processing the response to facilitate use of said second contact method to attempt to reach said called party" as is further required by claim 1. In particular, in Wood, upon receipt of the alleged "response", the called telephone number has already been used to establish the connection that is the alleged response. Then, Wood does not at all teach or even suggest any further "use of the [alleged] second contact method to attempt to use said called party". In any event, Wood simply does not teach or suggest any "automatically processing of the [alleged] response to facilitate use of the [alleged] second contact method to attempt to reach said called party".

For the above reasons, Applicants respectfully submit that, (1) even if Wood were somehow decided to be somehow used as a method to "locate the called party", and (2) even if the telephone connection message is alleged to correspond to the "sending" substep of claim 1, then (3) Wood simply cannot be construed as also teaching or suggesting the receiving and automatically processing substeps of claim 1. Indeed, as was made clear above, the Office Action did not even allege that Wood teaches or suggests all elements of all

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three substeps, or even that Wood teaches or suggests the automatically processing substep at all.

In fact, Wood's "telephone connection message" and Wood's resulting telephone connection teach away from the just-mentioned response-receiving substep of claim 1 because Wood's resulting telephone connection does not "indicate" what claim 1 recites, as a "response" to the sending that claim 1 recites.

Furthermore, there would have been no expectation of success for using Wood's "telephone connection message" as some type of "message requesting location information regarding said called party" as would be required by claim 1, because there would not be, from Wood's method, any proper as-claimed response, or any proper as-claimed automatically processing of the response.

For the just-discussed additional reasons, Applicants respectfully submit that claim 1 is further allowable over Wood. Again, if the Examiner wishes to maintain the rejection of claim 1 (or any other claims) after reconsideration, Applicants respectfully request that the Examiner please provide support for any such remaining rejection by specific reference to specific portions of cited art and/or an affidavit as required by 37 C.F.R. § 1.104(d)(2).

Dependent Claims 2-3, 21-23, 26, and 27

Claims 2-3, 21-23, 26, and 27 include all limitations of their base claim 1. Accordingly, Applicants respectfully submit that claims 2-3, 21-23, 26, and 27 are allowable over Wood for at least the same reasons, discussed above, as is claim 1.

In view of the preceding paragraph, Applicants respectfully submit that the assertions and rejections from the Office Action regarding the dependent claims 2-3, 21-23, 26, and 27 are rendered moot. Nevertheless, Applicants respectfully submit that the assertions regarding the dependent claims have their own deficiencies. Some examples of these deficiencies are presented below, for illustration.

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Claim 21 recites that the "second contact method includes a telephone number that is entered in full by a responding party". The Office Action did not address all elements recited in claim 21. In particular, the Office Action did not even allege that Wood or any other cited art teaches or suggests "by a responding party".

Claim 22 recites "first contact method includes an e-mail address". The "telephone connection message" of Wood simply is not taught or suggested as including an e-mail address. The telephone connection message of Wood that is alleged to correspond to claim 1's "message" is sent via an Internet connection via a browser. However, there is no indication in Wood that the Internet connection includes an e-mail address. The only mention of e-mail in Wood is in connection with sending e-mail, which has nothing to do with the "telephone connection message" that is alleged to elicit the claimed "response".

Claim 26 recites "... recording said second contact method and playing the response for said caller". The cited portion of Wood (col. 10, lines 34-43) simply does not in any way relate to "recording" or "playing" "the response".

The assertions from the Office Actions regarding the other dependent claims are at least similarly difficult to understand or parse, especially given the problems with the assertions regarding base claim 1. Therefore, it is difficult and not worthwhile to attempt to comment on them further at this time.

#### Claims 6 and/or 16

Claim 6 and not claim 16 was mentioned in the first sentence of Item 3 of the Office Action. However, claim 16 and its language, and not claim 6, was discussed in the body of Item 3 of the Office Action. Applicants believe that claim 16 and not claim 6 was meant to be mentioned in Item 3, given that only claim 16 of the two was discussed in detail in the body of Item 3. Nevertheless, Applicants distinguish both claims 6 and 16 from Wood below.

Claim 16 recites "sending out location request messages" and "receiving and handling responses, wherein a response ... indicates a second destination which is to be subsequently called". It is seen that these recitations of claim 16

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resemble similar recitations of claim 1 that have been distinguished above from Wood's method. In fact the "second destination which to be subsequently called" recitation of claim 16 is distinguishable even more clearly from Wood's method, because the alleged "response" in Wood's method is itself the connected telephone call, and thus the alleged "second destination" in Wood is already called and thus teaches away from claim 16's recital of the alleged second destination as being "to be subsequently called". Accordingly, Applicants respectfully submit that claim 16 is clearly allowable over Wood for at least the same reasons as is claim 1 and also for the additional reasons just stated in the present paragraph.

Claim 6 recites and "sending messages to multiple parties requesting location information regarding said called party". Wood simply does not teach or suggest such a feature, and the Office Action does not allege that Wood does teach or suggest such a feature. Accordingly, Applicants respectfully submit that claim 6 is clearly allowable over Wood.

Claims 4, 17-20, 28, and 33 under Section 103(a) [Item 4]

Claims 4, 17-20, 28, and 33 stand rejected under Section 103(a) as being unpatentable over Wood in view of Brennan. These claims include all limitations of their respective base claims 1 or 16. The cited Table 4.0 of Brennan merely handles telephone calls either by recording a message from the caller ("MESSAGE") or by transferring the call to another number in conventional fashion. The cited Table 5.0 of Brennan merely shows a subscriber profile entry. Therefore, Brennan does not, and was not alleged to, provide the features of claims 1 or 16 that are, as explained in detail above, completely missing from Wood.

Accordingly, Applicants respectfully submit that claims 4, 17-20, 28, and 33 are allowable for at least the same reasons, discussed above, as is claim 1. Therefore, Applicants respectfully submit that the assertions and rejections from the Office Action regarding the dependent claims 4, 17-20, 28, and 33 are rendered moot.

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Claim 24, 25, and 5 under Section 103(a) [Items 5, 6, 7]

Claim 24 stands rejected under Section 103(a) as being unpatentable over Wood in view of Cheston. Claim 25 stands rejected under Section 103(a) as being unpatentable over Wood in view of Herbst. Claim 5 stands rejected under Section 103(a) as being unpatentable over Wood in view of Brennan and further in view of Kugell.

None of Cheston, Herbst, or Brennan/Kugell does, or is alleged to, provide the features of claims 1 or 16 that are completely missing from Wood.

Accordingly, Applicants respectfully submit that claims 24, 25, and 5 are allowable for at least the same reasons, discussed above, as is claim 1. Therefore, Applicants respectfully submit that the assertions and rejections from the Office Action regarding the dependent claim 24, 25, and 5 are rendered moot.

Claim 6, 8-15, 29-32, 34, and 35 under Section 103(a) [Item 8]

Claims 6, 8-15, 29-32, 34, and 35 were rejected under Section 103(a) as being unpatentable over Kugell in view of Brennan. In the above amendments, claim 6 is amended to include all limitations of former claim 8, and claim 8 is canceled. (Claim 6 is also amended to remove a typographical error, "a".)

Claim 6

For convenience, claim 6 as amended is here reproduced.

6. *A method for [a] locating a called party comprising:*  
*receiving a request to locate a called party;*  
*automatically sending messages to multiple parties listed in*  
*a contact list requesting location information regarding said called*  
*party;*  
*canceled outstanding messages when a response is*  
*received to said messages; and*  
*presenting said response to a calling party.*

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The Office Action rejects claim 6 "for the same reasons as discussed ... with respect to claim 5". [Office Action, Item 8, page 7] Further, the Office Action conceded that "Kugell does not teach the method for locating a called party". The Office Action alleged, however, that "Brennan teaches the method for locating a called party". Applicants are uncertain as to what is meant in the Office Action's rejection and allegations regarding claim 6, especially given that claim 6 and claim 5 are different and are rejected on different art. Nevertheless, the precise meaning of the rejection and allegations regarding claim 6 are moot, in view of the amendment of claim 6 to include limitations of former claim 8.

As amended, claim 6 recites a step of "canceling outstanding messages when a response is received to said messages" and (based on former claim 8) a step of "presenting said response to a calling party". In connection with former claim 8, the Office Action alleged that "Brennan teaches receiving responses to said one or more messages and presenting a response to a calling party (col. 13, line 63 through col. 14, line 5)". Applicants respectfully disagree.

The entire portion of Brennan that is cited in the Office Action in connection with former claim 8, plus one additional line of Brennan, is merely the following:

*The call can be rejected because the subscriber is not there, or it can be accepted by the subscriber, or information about the call can be requested (e.g. CLID and urgency), and the call can then be accepted or rejected. The caller will not know if his call is being announced. He will receive the usual message indicating that an attempt is being made to contact the subscriber, and will either reach the subscriber (the call was accepted), continue to the next hunt location, or have the call completed elsewhere (e.g. the messaging service). This is shown in blocks 900-902 of FIG. 4. [Brennan, col. 13, line 63 through col. 14, line 6]*

As is seen from the above-quoted passage of Brennan, what causes early termination of the hunting is an acceptance of the call. If the call is accepted, then the call is simply connected and nothing is taught or suggested as being presented to the calling party. Indeed, the quoted passage of Brennan specifically teaches that "[t]he caller will not know if his call is being announced"--

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and thus teaches away from any "presenting" of the acceptance to the caller, given lack of contradicting indications in the context of Brennan and Kugell. Thus, even if Brennan's termination of linear hunting is combined with Kugell's termination of simultaneous hunting, Brennan does not teach all limitations of claim 6.

In stark contrast to claim 6, the only item "presented" to the caller in the quoted passage of Brennan is "the usual message indicating that an attempt is being made to contact the subscriber" [Brennan, passage quoted above], which is the system-welcome message that is appropriate when hunting among multiple phone numbers in Brennan. The passage states that "[h]e [i.e., the caller] will receive the usual message" [underlining added]. Thus, it is seen that Brennan's system-welcome message is sent regardless of how the call hunting ultimately proceeds.

The system-welcome message from Brennan cannot be construed to be the "response" recited in claim 6 at least because it would make no sense to "cancel[] outstanding messages [that request location information]" as required in claim 6 "when" Brennan's system-welcome message (if alleged as claim 6's "response") "is received". It would make no sense because Brennan's system-welcome message is always sent but the canceling in Brennan only sometimes occurs, and nothing else in Brennan can make sense of the discrepancy. Thus, a logical impossibility results from trying to read Brennan in a way to make sense of the rejection, and therefore the attempt to make sense of the rejection fails.

Accordingly, it is again seen that even if combined with Kugell's simultaneous hunting, Brennan and Kugell do not teach all limitations of claim 6. In fact, as discussed in a preceding paragraph, Brennan actually teaches away from the recitations of claim 6, in the context of Brennan and Kugell.

Accordingly, Applicants respectfully submit that claim 6 is allowable over Brennan in view of Kugell.

Claims 9-15 and 29-32

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Claims 9-15 and 29-32 include all limitations of their base claim 6. Accordingly, Applicants respectfully submit that claims 9-15 and 29-32 are allowable over Brennan and Kugell for at least the same reasons, discussed above, as is claim 6.

In view of the preceding paragraph, Applicants respectfully submit that the assertions and rejections from the Office Action regarding the dependent claims 9-15 and 29-32 are rendered moot. In view of uncertainty regarding the meaning of portions of the rejection and allegations regarding base claim 6, it would not be helpful to make further comments about the dependent claims 9-15 and 29-32 at this time.

#### Claims 34 and 35

Claim 34 recites, among other features:

*automatically sending one or more messages to parties listed in a contact list requesting location information regarding said called party, wherein said messages include a number or address at which said calling party may be reached by said parties listed in said contact list, and an instruction for said parties to directly contact said calling party via said number or address*  
[emphasis added]

The Office Action rejected claim 34 "for the same reasons as discussed ... with respect to claims 6 and 29". However, claim 34 recites features that are simply not anywhere recited in claims 6 or 29. For example, at least the features of claim 34 underlined above are not recited in claims 6 or 29. Accordingly, Applicants respectfully submit that a prima facie allegation of unpatentability has certainly not been made in the Office Action regarding claim 34 and its dependent claim 35, which includes all limitations of claim 34. For at least this reason, Applicants respectfully submits that claims 34 and 35 are allowable over Kugell in view of Brennan.

Claim 7 under Section 103(a) [Item 9]

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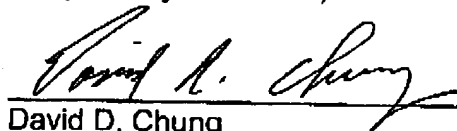
Claim 7 stands rejected under Section 103(a) as being unpatentable over Kugell in view of Brennan and further in view of Will. Claim 7 includes all limitations of its base claim 6, including the limitations explained above that are not anywhere provided by Kugell or Brennan. These limitations are also not provided by Will, and are not alleged to be provided by Will. Accordingly, Applicants respectfully submit that claim 7 is allowable over Kugell in view of Brennan and further in view of Will for at least the same reasons, discussed above, that claim 6 is allowable.

### CONCLUSION

Therefore, Applicants submit that their invention is not disclosed, taught, or suggested by the references of record. Therefore, it is submitted that all of the claims are allowable over the art of record and it is respectfully requested that the application be passed to allowance.

Respectfully submitted,

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VII. Version of Amendments with Markings to Show Changes Made

6. (Twice Amended) A method for [a] locating a called party comprising:  
receiving a request to locate a called party;  
automatically sending messages to multiple parties listed in a contact list  
requesting location information regarding said called party; [and]  
canceling outstanding messages when a response is received to said  
messages; and  
presenting said response to a calling party.